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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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20583 7590 01/17/2007  
JONES DAY  
222 EAST 41ST ST  
NEW YORK, NY 10017

EXAMINER
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BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/603,115

Applicant(s)

DING ET AL.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 111-170 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 111-170 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 111-113, 120-121, 124-125, 129-130, 136-137, 139-143, 150-151, 154-155, 159-160, 166-167 and 169-170 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg et al. (5,464,650). Berg et al. discloses a vascular stent having at least a portion which is implantable into the body of a patient, wherein at least a part of the stent portion is stainless steel (col. 3, lines 37-41) covered with a coating for release of a biologically active material, wherein said coating adheringly conforms to the stent structure and comprises an undercoat comprising an ethylene vinyl acetate copolymer material incorporating an amount of biologically active material therein for timed release therefrom which acts to inhibit smooth muscle cells in said patient (col. 4, line 35- col. 5, line 39), and wherein said coating further comprises a topcoat which at least partially covers the undercoat, said topcoat comprising a biostable, non-thrombogenic polymeric material which provides long term non-thrombogenicity to the stent portion during and after release of the biologically active material, and wherein said topcoat is ***substantially free of an elutable material***, i.e. ethylene vinyl acetate copolymer. Therapeutic substances, i.e. hirudin, are well known to one of ordinary skill in the art to inherently inhibit smooth muscle cell proliferation (i.e. Vlasuk et al.

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5,492,895, col. 5, lines 36-59). Berg et al. discloses that the coating can comprise several layers, therefore having an undercoat and a topcoat. However Berg et al fails to disclose the topcoat **free** of an elutable material.

As noted in MPEP 2144.05 (I), "a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties." "Substantially free" is close enough to free "that one skilled in the art would have expected them to have the same properties."

Differences in concentration do not support the patentability of subject matter unless there is evidence indicating such concentration is critical. The present specification discloses criticality in regards to the topcoat **substantially free** of an elutable material, not entirely free of an elutable material.

In addition, as noted in the Applicant's response:

"Moreover, the nature of the invention, i.e., coating a stent with a drug-free, pure polymer, is straightforward and not unduly complicated. The relative skill of those in the art of coating stents is high, and the art of coating stents is predictable. Finally, the breadth of the claims is reasonable and not overly broad. Thus, Applicants submit that the instant specification fully enables one of skill in the art to make and use the invention commensurate in scope with the claims without undue experimentation."

Therefore it would be obvious to one of ordinary skill to have the topcoat free of an elutable material because they would expect it to have the same properties as a topcoat substantially free of an elutable material, and it would not require undue experimentation to determine the optimal amount of elutable material within the topcoat.

Claims 114-119, 122-123, 126-128, 131-135, 138, 144-149, 152-153, 156-158, 161-165 and 168 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg

et al. (5,464,650) as above, in further view of Mitchell et al. (5,288,711). Berg et al. discloses a coated vascular stent as above however Berg et al. also fails to disclose the coating comprising an antibiotic. Mitchell et al. teaches a stent comprising an antibiotic (Rapamycin) to inhibit proliferation of vascular smooth muscle cells (col. 3, lines 7-31). It would have been obvious to one of ordinary skill in the art to combine the teaching of a stent comprising an antibiotic, as taught by Mitchell et al., to a coated vascular stent as per Berg et al., in order to inhibit proliferation of vascular smooth muscle cells.

### ***Response to Arguments***

Applicant's arguments, filed November 2 2006, have been fully considered and are persuasive. The 112 first paragraph rejection has been withdrawn.

As noted in prior office actions, Berg et al discloses a plurality of layers, therefore at least an undercoat and topcoat. In column 2, lines 44-67, Berg et al discloses:

"The release rate can be further controlled by varying the ratio of drug to polymer in the multiple layers.

Berg et al suggests a topcoat that is substantially free of an elutable material. In column 5, lines 12-18, Berg discloses:

"More polymer may be needed if it has relatively poor efficacy in retaining the therapeutic substance on the stent and more polymer may be needed in order to provide an elution matrix that limits the elution of a very soluble therapeutic substance. A wide ratio of therapeutic substance to polymer could therefore be appropriate and could range from about 10:1 to about 1:100."

Therefore the therapeutic substance to polymer ratio of 1:100 could easily be considered substantially free of an elutable material. As noted above, "Substantially

free" is close enough to free that one skilled in the art would have expected the topcoat of Berg to have the same properties as the present invention.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746/4746. The examiner can normally be reached Tuesday-Friday between Mon.-Fri. from 9:00-5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754/272-4754. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas C. Barrett  
Examiner  
Art Unit 3738



**TOM BARRETT  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3700**